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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

BISMARCK et al.

Appl. No. 09/769,289

Filed: January 26, 2001

For: METHOD OF AND APPARATUS
FOR MAKING COMPOSITE
CONTAINERS WITH
IDENTIFYING INDICIA

Art Unit: 2876

Examiner: Uyen Chau N. Le

Atty. Docket No. 31653-167874

Customer No.

26694

PATENT TRADEMARK OFFICE

Request for Reconsideration

Commissioner for Patents

U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window, Mail Stop Amendment
Crystal Plaza Two, Lobby, Room 1B03
Arlington, Virginia 22202

Sir:

In reply to the Office Action dated September 23, 2003, Applicants submit the following
Request for Reconsideration.

A one month extension of time is hereby petitioned. Authorization is hereby granted to
charge the \$110.00 extension fee and any other required fees Deposit Account No. 22-0261.

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Remarks

Reconsideration of this Application is respectfully requested.

Claims 1-22 are pending in the application, with claims 1 and 15 being the independent claims.

The indication that claims 1-14 are allowed is gratefully noted.

Claims 15-22 stand rejected under 35 U.S.C. §103 as being unpatentable over U.S. Patent No. 4,836,378 to Lephardt ("Lephardt") in view of U.S. Patent No. 4,077,289 to Rudszinat ("Rudszinat") and U.S. Patent No. 5,190,428 to Bryant et al. ("Bryant").

Initially, it is not clear to the Applicants how claim 1 is allowed while claim 15 is rejected. Claim 15 is essentially a "means for" apparatus claim corresponding to the allowed method claim 1. Although the Applicants pointed out this issue in the filed June 30, 2004, this issue was not addressed in the final Office Action. In any event, clarification is still requested.

On page 4 of the Action, the Examiner states the following:

Allowable Subject Matter

4. Claims 1-14 are allowed.

5. The following is a statement of reasons for the indication of allowable subject matter: The prior art of records to Lephardt, Rudszinat, Bryant et al and all other cited references, taken alone or in combination, fails to teach or fairly suggest the specific method of confining a commodity in a composite container having a plurality of constituents comprising, among other steps, providing at least some of the constituents with characteristics indicia and processing the characteristic indicia

into information which is characteristic of the composite container as set forth in the claims. (emphasis added)

Rejected claim 15 recites: "means for providing at least some constituents...with characteristic indicia...[and] means for processing the characteristic indicia...into information which is characteristic of each individual assembled container." Thus, claim 15 recites the features which the Examiner admits are not taught by the prior art. As such, claim 15 should be allowable.

In the Response to Arguments in the Action, the Examiner states: "claim 15 does not necessary [sic] claim applying to each constituent individually[, instead, claim 15 recites] merely providing indicia to 'at least some,' which happens [in Lephardt] by providing indicia to all by marking the box/container..."

Admittedly, claim 15 does recite "means for providing *at least some* constituents...with characteristic indicia." However, allowed claim 1 also recites "providing *at least some* of the constituents with characteristic indicia". It appears that the Examiner is interpreting this phrase differently for claim 1 and 15. It is also noted that in the main discussion of the rejection in the Action, the Examiner states "Lephardt fails to teach or fairly suggest the step of providing characteristic indicia, which is randomly selected and is processed into information." This seems inconsistent with the Examiner's statement in the Response to Arguments.

In any event, it is respectfully submitted that claim 15 is allowable over the combination of Lephardt, Rudszinat and Bryant.

Claim 15 requires that the composite container has a plurality of constituents. The constituents of the container are then provided with characteristic indicia. This characteristic indicia is processed into information characteristic of the assembled container. In Lephardt, the identity of the cigarette maker is not "provided" to the constituents of the container. Furthermore, the characteristic indicia is not processed into information which is "characteristic of the assembled container." The "characteristic indicia" of Lephardt is characteristic of the maker of the cigarette or characteristic of when the cigarette was made. The claim requires that the information be characteristic of the assembled container.

Although, as discussed above, the Examiner's rationale for rejecting the claim is unclear, the Examiner appears to argue in the Response to Arguments that providing the container with indicia as disclosed in Lephardt is analogous to providing identifying indicia to "at least some" of the constituents, as recited in claim 15, by providing indicia to all, as argued by the Examiner. Even if, assuming for the sake of argument, that this is true, the Examiner's argument ignores the claim recitations that the indicia is then processed into information which is characteristic of each individual assembled container and encoded upon each individual container. Under the Examiner's interpretation, the container of Lephardt would have to be provided/encoded with information twice, which is clearly not the case.

Claim 15 is allowable. Claims 16-22 depend from claim 15 and are patentable over any combination of the cited art.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is hereby invited to telephone the undersigned at the number provided.

A Notice of Allowance with claims 1-22 is respectfully requested.

Respectfully submitted,

Date: 01/23/04



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